

Appl. No. 10/763,718
Amdt. and Resp. dated Nov. 28, 2005
Attorney Docket No. M005Z/281291
Reply to Office action of Aug. 26, 2005

Amendments to the Drawings:

The attached drawing sheet includes new Fig. 14. No new matter is added by this amendment. Support for Fig. 14 may be found at least in the paragraph beginning on page 5 and ending on page 6 of the application and in the last paragraph on page 9 of the application.

Attachment: New Sheet

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REMARKS

The undersigned thanks Examiner Sang for thoroughly reviewing the present application.

In an August 26, 2005 Office action (the "Office Action"), the Examiner objected to the drawings under 37 C.F.R. §1.83(a), rejected claims 1-2, 5, 8-15 and 18 under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1-17 of U.S.P.N. 6,416,012, rejected claims 1-3 and 5 under 35 U.S.C. §102(b) as anticipated by U.S.P.N. 4,659,029 to Rodriguez ("Rodriguez '029"), rejected claims 8-16, 18 and 21 under 35 U.S.C. §103(a) as unpatentable over Rodriguez '029 in view of U.S.P.N. 6,305,634 to Rodriguez ("Rodriguez '634"), and indicated that claims 4, 6-7, 17 and 19-20 would be allowable if rewritten in independent form to include all of the limitations of the relevant base claim and intervening claim(s).

Upon entry of the present amendment, claims 1-21 are pending, the specification is amended, claims 1, 9 and 13 are amended, and new Figure 14 is added. No new matter has been added by this amendment. Based on the above amendments and the below remarks, the undersigned is of the opinion that all pending claims are in a condition of allowance, and respectfully requests that the Examiner issue a notice of allowance in accordance with the same.

Drawing Objections

On page 2 of the Office Action, the Examiner objects to the drawings under 37 C.F.R. §1.83(a), stating that "a system with a first spool, a second spool, a nip between the second spool and the paper web, and a computer controlling the pneumatic system' recited in claims 1, 12-13 and 21 must be shown or the feature(s) cancelled from the claim(s)."

The undersigned respectfully traverses the objection to the drawings with respect to claims 1 and 13. C.F.R. §1.83(a) states in part: "The drawing in a

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nonprovisional application must show every feature of the invention specified in the claims." Id. (emphasis added). The drawings originally submitted in connection with this application do show "every feature of the invention specified" in claims 1 and 13.

The first spool, second spool, and nip between the second spool and paper web are not features of the invention of claims 1 and 13.¹ The invention of claim 1 is a "system for cutting a traveling web of paper" comprising a "transfer track" and a "drive assembly... capable of being powered by manual power or motor power." The first spool, second spool, and nip, although mentioned in the preamble and other portions of the claim, are not features of the claimed "system for cutting a traveling web of paper," but are merely features of a larger system for collecting a traveling paper web onto spools. Similarly, the invention of claim 13 is a "system for cutting a traveling web of paper" comprising a "transfer track" and a "drive assembly." The first spool, second spool, and nip, although mentioned in the preamble and other portions of the claim, are not features of the claimed "system for cutting a traveling web of paper," but are merely features of a larger system for collecting a traveling paper web onto spools.

Although the undersigned respectfully traverses the Examiner's drawing objections with respect to claims 1 and 13, in the interest of expediting the prosecution of the present application, the undersigned submits new Fig. 14, which schematically shows the first spool, second spool, nip between the second spool and paper web, and a computer controlling the pneumatic system. Fig. 14 does not include any new matter and is supported by the specification as originally filed. Support for Fig. 14 may be found at least in the paragraph beginning on page 5 and

¹ The computer controlling the pneumatic system is only mentioned in claims 12 and 21.

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ending on page 6 of the application² and in the last paragraph on page 9 of the application.³

In light of the above traversal and submission of new Fig. 14, the undersigned respectfully requests the Examiner to withdraw the objection to the drawings.

Double Patenting Rejections

On pages 2-3 of the Office Action, the Examiner rejects claims 1, 2, 5, 8-15 and 18 under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1-17 of USPN 6,416,012. On page 3 of the Office Action, the Examiner states that:

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application and of the patent are drawn to the same invention, but differ only in specificity and obvious wording changes. The invention broadly claimed in this application is obviously encompassed by the claims of the patent.

The undersigned respectfully traverses this rejection and requests reconsideration and withdrawal thereof.

An obviousness-type double patenting rejection is only proper if the "claimed subject matter is not patentably distinct from the subject matter claimed in [the] commonly owned patent...." M.P.E.P. § 804 (II) (B) (1). The analysis for obviousness-type double patenting "parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination." Id.

² "[T]he turn-up tape system 100 is positioned in relation to a paper web, empty spool (a second) and full (first) spool so that the paper web travels over the horizontal section of the transfer track and the turn-up section is positioned to deliver the turn-up tape to a nip between the paper web and empty spool."

³ "In one embodiment, the operation of the turn-up tape system 100, except for the drive assembly 102, is controlled by a pneumatic system that can be controlled automatically, such as by a computer or can be controlled manually."

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Here, the undersigned respectfully submits that the subject matter of claims 1, 2, 5, 8-15 and 18 are patentably distinct from the subject matter claimed in USPN 6,416,012.

For example, claims 1, 2, 5, and 8-12 claim inventions that are patentably distinct from the claims of USPN 6,416,012. Independent claim 1 as amended, and therefore dependent claims 2, 5, and 8-12, claim a system for cutting a traveling web of paper that includes a drive assembly "capable of being powered by **both** manual power and motor power." Although USPN 6,416,012 claims a "drive" for driving a turn-up tape along a transfer track, it does not affirmatively claim a drive assembly capable of being powered by both manual power and motor power. Moreover, the drive assembly claimed in claims 1, 2, 5, and 8-12 of the present application is not an obvious modification to the drive claimed in USPN 6,416,012. Nothing in USPN 6,416,012 teaches, suggests or discloses a drive assembly that can be powered by both manual power and motor power. As such, claims 1, 2, 5, and 8-12 are patentably distinct from the claims of USPN 6,416,012.

Claims 13-15 and 18 also claim inventions that are patentably distinct from the claims of USPN 6,416,012. Independent claim 13 as amended, and therefore dependent claims 14, 15 and 18, claim a system for cutting a traveling web of paper that includes a "transfer track" including at least in part a "V-shaped groove" "wherein the second side wall [of the V-shaped groove] comprises a concave portion." Unlike claims 13-15 and 18 of the present application, USPN 6,416,012 claims a transfer track including a groove having a "first top wall," "a first side wall," and "a first bottom wall" (See e.g., USPN 6,416,012, claim 1) and, in alternate embodiments, claims a transfer track including a "V-shaped groove formed by a substantially vertical side wall and a second side wall at an acute angle from the substantially vertical side wall" (See e.g., Id. at claim 14). None of the claims of USPN 6,416,012, however, affirmatively claim a V-shaped groove including a concave portion in one of the groove's sidewalls. Moreover, the transfer tracks

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claimed in claims 13-15 and 18 are not obvious modifications of the transfer tracks claimed and disclosed in USPN 6,416,012. Nothing in USPN 6,416,012 teaches, suggests, or discloses a transfer track that includes a V-shaped groove including a concave portion in one of the groove's sidewalls.

Because claims 1, 2, 5, 8-15 and 18 claim subject matter that is patentably distinct from the subject matter claimed in USPN 6,416,012, the undersigned respectfully requests the withdrawal of the obviousness-type double patenting rejection.

§102 Rejections

On pages 3-4 of the Office Action, the Examiner rejects claims 1-3 and 5 under 35 U.S.C. §102(b) as anticipated by Rodriguez '029. With respect to claims 1, 3, and 5, the Examiner states on page 4 of the Office Action that Rodriguez '029 "teaches a system for cutting a traveling web from a first spool and onto a second spool by feeding a turn-up tape (24) along a transfer track (28) beneath the paper web (20) and to a position adjacent to the nip (52); and a drive assembly (43, i.e., a hand crank) capable of driving the turn-up tape along the transfer track toward the nip, wherein the drive is capable of being powered by manual power or motor power, see figure 1, and on column 8, lines 59-61." With respect to claim 2, the Examiner states on page 4 of the Office Action that Rodriguez '029 teaches a "drive assembly with a drive shaft (108) coupled to a drive wheel (41), the drive assembly with an engaging wheel (55) engaging the turn-up tape between the drive wheel (41), see figure 2." The undersigned respectfully traverses these rejections and requests reconsideration and withdrawal thereof.

To anticipate a claim, a reference must teach each and every element of the claim, either expressly or inherently. See M.P.E.P. § 2131. Rodriguez '029 does not teach each and every element of amended claim 1 and therefore does not teach each and every element of claims 2, 3, and 5, which depend from claim 1.

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For example, amended claim 1, and therefore dependent claims 2, 3 and 5, require a drive assembly capable of being powered by both manual power and motor power. Rodriguez '029 does not teach, suggest or disclose a drive assembly capable of being powered by both manual power and motor power. Although Rodriguez '029 does teach converting a manually operated drive assembly into a "power assisted" drive assembly, it does not teach, suggest or disclose converting the manual drive assembly such that it could be powered by both manual and motor power. Merely converting a drive assembly from receiving one type of power to another does not constitute transforming the drive assembly such that it can function by both manual power and motor power, which, for example, may allow the drive assembly to normally function on motor power, but function on manual power when motor power is not available.

Because Rodriguez '029 does not teach, suggest or disclose a drive assembly capable of being powered by both manual power and motor power, the undersigned respectfully requests the Examiner to withdraw the §102 rejections to claims 1-3 and 5.

§103 Rejections

On pages 4-7 of the Office Action, the Examiner rejects claims 8-16, 18 and 21 under 35 U.S.C. §103(a) as unpatentable over Rodriguez '029 in view of Rodriguez '634. The undersigned respectfully traverses these rejections and requests reconsideration and withdrawal thereof.

To establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. See M.P.E.P. § 2142.

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Here, the undersigned submits that the Examiner has failed to establish a prima facie case of obviousness at least for the reason that the cited references, whether alone or in combination, do not teach or suggest all the claim limitations.

On page 5 of the Office Action, with respect to claims 8-10, 13, 14, 16 and 18, the Examiner states that "Rodriguez '029 discloses the claimed invention except for a V-shaped groove for the transfer track along with a flexible seal" and that it "would have been obvious ... to modify the track with a V-shape groove and a flexible seal to prevent any debris from entering as taught in Rodriguez '634...." Neither Rodriguez '029 nor Rodriguez '634, whether alone or in combination, however, teach, suggest or disclose all the claim limitations of claims 8-10, 13, 14, 16 and 18.

Claims 8-10 depend from claim 1. As discussed above, amended claim 1 requires a drive assembly capable of being powered by both manual power and motor power, which is not taught, suggested or disclosed by Rodriguez '029. Rodriguez '634 does not teach, suggest or a drive assembly capable of being powered by both manual power and motor power either.

Furthermore, neither Rodriguez '029 nor Rodriguez '634, whether alone or in combination, teach, disclose or suggest all of the limitations of claims 13, 14, 16 and 18. For example, independent claim 13 as amended, and therefore dependent claims 14, 16 and 18, all require a transfer track including at least in part a V-shaped groove wherein the second side wall (of the V-shaped groove) comprises a concave portion. As described in the specification, in some embodiments, the concave portion may "help to alleviate binding of the turn-up tape 1000 in the groove 1004" and/or may "prevent any adhesive that may be on the turn-up tape 1000 from attaching to the groove 1004 or otherwise preventing the turn-up tape 1000 from traveling through groove 1004." See application, page 7, para. 2. Neither of the references cited by the Examiner, whether or alone or in combination, teaches, suggests, or discloses a side wall portion of a V-shaped groove that is concave.

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Page 6 of the Office Action also cites Rodriguez '029 and '634 against claims 11 and 12. Claims 11 and 12, like claims 8-10, depend from amended claim 1 and require a drive assembly capable of being powered by both manual power and motor power. As discussed above, neither of the references cited, whether alone or in combination, teaches, suggests or discloses a drive assembly capable of being powered by both manual power and motor power.

Page 6 of the Office Action also cites Rodriguez '029 and '634 against claim 15. Claim 15, like claims 14, 16 and 18, depend from amended claim 13 and require a transfer track including at least in part a V-shaped groove with a second side wall having a concave portion. As discussed above, neither of the references cited, whether alone or in combination, teaches, suggests or discloses a transfer track including at least in part a V-shaped groove with a second side wall having a concave portion.

Finally, on pages 6 to 7 of the Office Action, with respect to claim 21, the Examiner stated that the "method described in [this] claim would inherently result from the use of the invention of Rodriguez '029 and '634...." Neither Rodriguez '029 nor Rodriguez '634, however, whether alone or in combination, teach, suggest or disclose all the claim limitations of claim 21. For example, claim 21 requires a "drive" to be "powered by an electric motor" in one mode and switched "to a manual mode, wherein the drive is manually powered." As discussed above, neither Rodriguez '029 nor Rodriguez '634, whether alone or in combination, teach, suggest, or disclose a single drive that can be powered by both an electric motor and manual power.

The undersigned respectfully submits that neither of the cited references, whether alone or in combination, teaches, suggests or discloses all the limitations of claims 8-16, 18 and 21 and that therefore the prima facie requirements for a §103 rejection are not met. As such, the undersigned respectfully requests the Examiner to withdraw the §103 rejections to claims 8-16, 18 and 21.

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CONCLUSION

In light of the above amendments and remarks, the undersigned is of the opinion that the Office Action has been completely responded to and that the application is now in condition for allowance. Such action is respectfully requested.

If the Examiner believes any informalities remain in the application that may be corrected by Examiner's Amendment, or there are any other issues that can be resolved by telephone interview, a telephone call to the undersigned attorney at (404) 815-6291 is respectfully solicited. The undersigned authorizes the Commissioner to charge any additional fees that may be due for this Amendment and Response, or credit any overpayment, to Deposit Account No. 11-0855.

Respectfully submitted,



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